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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,077	10/28/2003	Lane W. Lee	M-15255 US	5959
32605 7590 11/30/2007 MACPHERSON KWOK CHEN & HEID LLP 2033 GATEWAY PLACE SUITE 400 SAN JOSE, CA 95110			EXAMINER SANDOVAL, KRISTIN D	
			ART UNIT 2132	PAPER NUMBER
			MAIL DATE 11/30/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/696,077

Applicant(s)

LEE ET AL.

Examiner

Kristin D. Sandoval

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 and 29-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-31 are pending.

Election/Restrictions

2. Applicant's election without traverse of claims 14-28 in the reply filed on September 19, 2007 is acknowledged.

Terminal Disclaimer

3. The terminal disclaimer filed on May 23, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 7,110,982 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

4. The affidavit under 37 CFR 1.132 filed May 23, 2007 is sufficient to overcome the rejection of claims 14-28 based upon the Lee et al., U.S. Patent No. 6,636,966 reference applied under 35 U.S.C. 102(e).
5. Applicant's arguments, see applicant's remarks, filed May 23, 2007, with respect to the rejection(s) of claim(s) 1-31 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Kitamura et al.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 14, 16, 21 and 23-25 rejected under 35 U.S.C. 102(e) as being anticipated by Kitamura et al. (Kitamura), U.S. Patent No. 6,816,948.

As per claims 14 and 23-25:

Kitamura discloses a system comprising:

A host system, the host system configured to request for file system objects stored by a storage device by identifying the block addresses containing a requested file system object and requesting the storage device to return the content stored at the identified block addresses the host system being further configured to identify the file system object to the storage device if the requested file system object comprises secure content; and

a storage device having:

a storage medium, configured to store security metadata for the secure file system objects; and

a storage engine, the storage engine being configured to respond to block-level requests from the host system by retrieving the content stored at the requested block addresses from the storage medium, the storage engine being further configured to access the security metadata if the block-level requests correspond to content comprising a secure file system object (4:16-39, 5:1-56, 6:37-54)).

As per claims 16 and 21:

Kitamura further discloses a system wherein the storage engine is configured to change the security metadata for a secure file system object in response to an internet transaction with a validated host system (6:4-33).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 15, 17-21, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura in view of Ta et al., U.S. Patent No. 7,168,787 B1, (hereinafter "Ta").

Regarding **claims 15, 19 and 26**: Kitamura discloses that the security metadata includes a locking indicator, the storage engine being configured to prevent access to the corresponding file system object content if the locking indicator indicates the file system object is locked (col. 8 lines 15-29).

Kitamura does not disclose that the storage engine is configured to assert the locking indicator if the play flag indicates that the host system has no remaining play rights.

Ta discloses that the storage engine is configured to assert the locking indicator if the play flag indicates that the host system has no remaining play rights (col. 12-13 lines 46-53 and col. 14 lines 17-24).

Therefore it would have been obvious to one skilled in the art at the time of the invention to modify Kitamura by the play control taught by Ta in order to create media that would be self-protecting against unauthorized viewing, (*See* Ta col. 5 lines 20-28).

Regarding **claims 17 and 27**: Kitamura does not disclose that the security metadata includes a play flag, the play flag indicating how many times the corresponding file system object may be played by the host system, the storage engine being configured to prevent access to the corresponding file system object if the play flag indicates that the host system has no remaining play rights.

Ta discloses that the security metadata includes a play flag, the play flag indicating how many times the corresponding file system object may be played by the host system, the storage engine being configured to prevent access to the corresponding file system object if the play flag indicates that the host system has no remaining play rights (col. 12-13 lines 46-53 and col. 14 lines 17-24).

Therefore it would have been obvious to one skilled in the art at the time of the invention to modify Kitamura by the play control taught by Ta in order to create media that would be self-protecting against unauthorized viewing, (*See* Ta col. 5 lines 20-28).

Regarding **claim 18**: Kitamura does not disclose that the storage engine is configured to erase the security metadata if the play flag indicates that the host system has no remaining play rights.

Ta discloses that the storage engine is configured to erase the security metadata if the play flag indicates that the host system has no remaining play rights (col. 15-16 lines 14-9).

Therefore it would have been obvious to one skilled in the art at the time of the invention to modify Kitamura by the play control taught by Ta in order to create media that would be self-protecting against unauthorized viewing, (*See* Ta col. 5 lines 20-28).

Regarding **claims 20 and 28**: Kitamura does not disclose that the security metadata includes a copy flag, the copy flag indicating how many times the host system may copy the corresponding file system object, the storage engine being configured to prevent access to the corresponding file system object if the copy flag indicates that the host system has no remaining copy rights.

Ta discloses that the security metadata includes a copy flag, the copy flag indicating how many times the host system may copy the corresponding file system object, the storage engine being configured to prevent access to the corresponding file system object if the copy flag indicates that the host system has no remaining copy rights (col. 12-13 lines 46-53 and col. 14 lines 17-24).

Therefore it would have been obvious to one skilled in the art at the time of the invention to modify Kitamura by the copy control taught by Ta in order to create media that would be self-protecting against unauthorized viewing, (*See* Ta col. 5 lines 20-28).

8. Claim 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura in view of Okaue et al. (Okaue), U.S. Patent No. 7,124,436.

As per claim 22:

Kitamura fails to teach the use of keys and encryption. However, Okaue discloses a system wherein the storage engine is configured to generate a secure session key, the storage engine generating the security metadata for each secure file system object by receiving a

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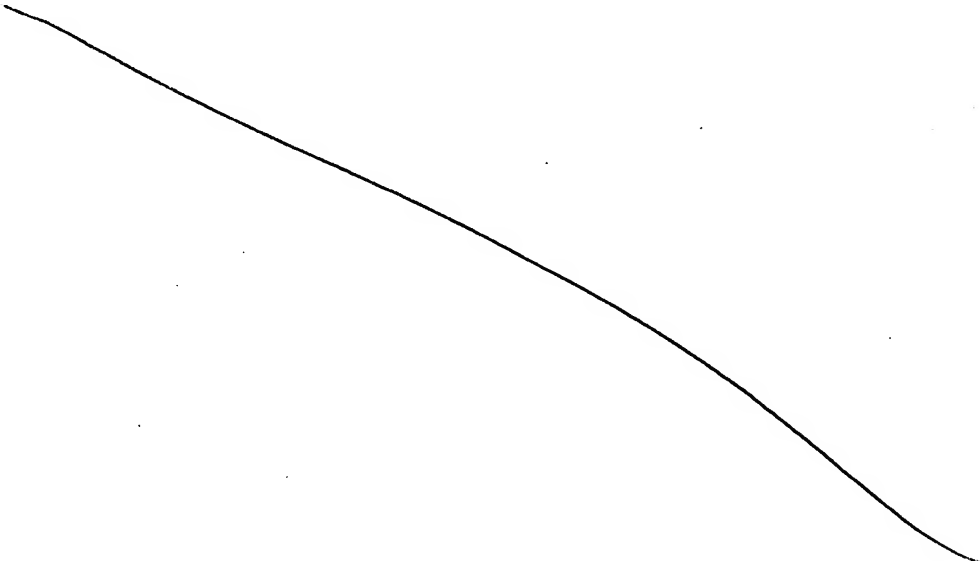
corresponding encrypted content key from the host system, wherein the content key has been encrypted by the host system using the secure session key, the storage engine being further configured to decrypt the encrypted content key using the secure session key and to encrypt the decrypted content key with a first storage engine encryption key and to write the storage-engine-encrypted content key to the storage medium (11:44-61).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize encryption in a storage unit in order to prevent unauthorized access to data stored in it's memory as taught by Okaue (1:14-17).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristin D. Sandoval whose telephone number is 571-272-7958. The examiner can normally be reached on Monday - Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

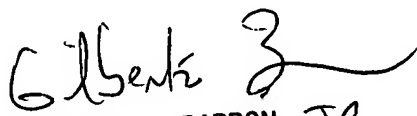


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kristin D Sandoval
Examiner
Art Unit 2132


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